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REMARKS

Claims 1 to 11, 13, 14, 21 to 33, 35, 36, and 43 to 50 are pending in the present application. Claim 46 has been amended to more particularly point out and distinctly claim the invention as discussed below. Support for the amendment to Claim 46 may be found on page 18, line 12 to page 19, line 2. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Upon review of the file Applicants noted that two Information Disclosure Statements, one filed on December 17, 2002 and one filed on July 17, 2001 apparently have not been considered as the Applicants have not received an initialed copy. Applicants respectfully request that a signed and initialed copy of these Information Disclosure Statements be sent with the next communication from the Examiner. This request was made in a previous communication but no response was received.

Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 46 to 49 stand rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has indicated that the variables x and y are not defined making the breadth of the claim unclear. Accordingly Applicants have amended Claim 46 to recite the penetration value limits as disclosed in the specification. As readily understood by one of ordinary skill in the art viscosity (which is equivalent to the penetration value) is directly related to the molecular weight. As such Applicants assert that the inclusion of the penetration value in the amended claim clarifies the breadth of the claims. Accordingly Applicants request allowance of these claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-9, 12, 14, 21-31, 35, 36, and 43-50 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,852,085 to Brown et al. (hereinafter referred to as "Brown") in view of U.S. Patent No. 5,391,594 to Romenesko et al. (hereinafter referred to as "Romenesko"). The Examiner has asserted that one of ordinary skill in the art would have been motivated by the teachings of Romenesko to add the silicone rubber powder

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taught therein to the thermoplastic composition of Brown in an effort to obtain the known benefits and improvements. Applicants respectfully traverse this rejection.

Brown discloses "thermoplastic compositions" which meet the long felt need for transparent articles. (Col. 2, lines 11-12) The transparent composition comprises a polyetherimide resin, at least one resin selected from the group consisting of polycarbonate resins, poly(ester-carbonate) resins, and polyarylate resins, and an effective amount of a catalyst to provide transparency to the composition. The required inclusion of the catalyst emphasizes the desire for transparency. Brown does not teach or suggest the inclusion of a polysiloxane. Brown does suggest the composition may be modified, at the expense of transparency, in order to gain some other property advantage. Among the list of these additives supplementary flame retardants are mentioned (Col. 16, line 33).

Romenesko discloses a free-flowing silicone polymer powder prepared by mixing a polydiorganosiloxane with a silica filler. The silicone polymer powder may be dispersed in an organic resin and improve the burn character of the resin. (Abstract) Exemplary organic resins include polyimides and polycarbonates. (Col. 4, line53 to Col. 5, line2) Romenesko does not teach or suggest the use of the silicone polymer powder with a polyester carbonate as is instantly claimed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that there is no reasonable expectation of success for the proposed modification of the prior art, namely the use of the silicone polymer powder of Romenesko in the composition of Brown. The combination of Brown and Romenesko results in a composition comprising polyetherimide resin, at least one resin selected from the

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group consisting of polycarbonate resins, poly(ester-carbonate) resins, and polyarylate resins, an effective amount of a catalyst to provide transparency to the composition, and a silicone polymer powder. Given the notorious unpredictability of the chemical arts and in particular the notorious unpredictability of catalytic chemistry there can be no expectation of success for this combination. The catalyst may affect the silicone polymer powder in an unpredictable, particularly when the silicone polymer powder is in combination with the polyetherimide and a resin selected from the group consisting of polycarbonate resins, poly(ester-carbonate) resins, and polyarylate resins. In addition, Applicants respectfully note that the instantly claimed compositions do not recite the presence of a catalyst to provide transparency to the composition.

A modification of Brown and Romenesko that is more closely analogous to the claimed elements requires the subtraction of the catalyst from the composition of Brown and the addition of the silicone polymer powder of Romenesko to the modified Brown composition. Applicants respectfully assert that there is no motivation in the prior art to modify the references in this way because Brown does not teach that the catalyst is optional and Romenesko is silent with regard to said catalyst and thus cannot teach or suggest its removal.

Applicants further maintain that the Examiner has used an improper standard in arriving at the rejection of the above claims under section 103, based on improper hindsight which fails to consider the totality of applicant's invention and to the totality of the cited references. More specifically the Examiner has used Applicant's disclosure to select portions of the cited references to allegedly arrive at Applicant's invention.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

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If there are any additional charges with respect to this Amendment or otherwise,
please charge them to Deposit Account No. 07-0862 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP

By Patricia S. DeSimone
Patricia S. DeSimone
Registration No. 48,137

Date: February 5, 2004
Customer No.: 23413
Telephone: (860) 286-2929